

Application No. 10/589,459
AMENDMENT dated November 16, 2010
Reply to Office Action of August 17, 2010
Attorney Docket 1410-67681-US

REMARKS

Claims 36-51 are canceled herein. Claims 52-67 are new, support for which can be found at least at paragraphs [0156]-[0164] and Figures 22-24 of the Specification. Therefore, claims 1-35 and 52-67 are presently under examination.

Rejections Under 35 U.S.C. § 103

Claims 1-25 stand rejected under 35 U.S.C. § 103(a) as obvious over Burrows et al. US 6,968,775 B2 ("Burrows"), and in view of Cai US 7,032,503 B2 ("Cai").

With regard to claim 1, the applied references fail to disclose or suggest an insert for use in a beverage preparation machine of a type comprising a brew head "such that, in use, water from the inlet of the brew head passes upwardly through the inlet of the insert into the brewing volume and such that beverage produced from the water and the quantity of beverage ingredients passes downwardly through the outlet of the insert" as recited in claim 1.

In reference to the Amendment filed June 16, 2010 and the arguments presented in reference to claim 1, the Response to Arguments section of the present Office Action states:

The examiner respectfully disagrees. Firstly, as rejected above, water is communicated **upwardly** in chamber 70 and the brewing volume through feed port 64 (inlet) (Burrows, col. 5, line 50-51); secondly, the beverage flows out through the holes of mash (outlet) downwardly because of **gravity**.

(Office Action, page 9) (emphasis in original).

First, Applicants respectfully disagree that the structures indicated in the Office Action disclose or suggest the structural arrangement recited in the present claims. The Office Action correctly asserts that water is communicated upwardly into plenum chamber 70 through a feed port 64. However, the plenum chamber 70 is not the brewing volume containing the beverage ingredients, as claimed. Rather, the plenum chamber 70 is upstream of the interior of the brew basket containing ground coffee and is for distributing water to at least one of the hollow ribs 72 formed in the side wall of Burrows' brew basket 12. (Burrows, Col. 5, lines 49-54). Supplying

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water into the plenum chamber 70 is different from water passing upwardly into the brewing volume, as claimed.

Further, the Burrows describes the arrangement of the ribs as follows:

The bottom wall 68 is formed to include the downwardly open feed port 64 for communicating hot water inflow upwardly into a false bottom or plenum chamber 70 (FIG. 10) which distributes the hot water flow to at least one and preferably a plurality of hollow ribs 72 formed in the side wall 68. In the preferred configuration as shown, three of said hollow ribs 72 are formed in the side wall 68 at approximate 120° intervals, and each of these ribs 72 includes a closed upper end and has at least one and preferably multiple jet ports 14 formed along the height thereof for jetting hot water streams into the interior of the brew basket 12. FIGS. 6-7 and 9-10 illustrate each hollow rib 72 with a pair of vertically spaced jet ports 14 positioned and aimed for jetting water streams generally tangentially in a common swirling direction (clockwise, as viewed in FIG. 9) into the brew basket interior.

(Burrows, Col. 5, lines 54-64) (emphasis added). As each of the ribs 72 are described having “a closed upper end,” water exiting the ribs 72 does not describe the water passing upwardly into the brew volume. Instead, Burrows describes the water entering the brew basket 12 as being aimed tangentially to create a swirling motion of the water and coffee grounds and that this swirling motion is important in the brewing process of Burrows (Burrows, Col. 6, lines 14-25).

Second, Applicants respectfully assert that the Office Action’s allegation that the brewed beverage of Burrows passes downwardly through the filter elements 78 is incorrect. The filter elements 78 are provided in the side wall 68 of the brew basket 12, such that the flow is radially outward from the brew basket. This is described in Burrows as follows:

This spinning fluidized bed is directed by centrifugal action in a generally radially outward direction against an inboard side wall of the brew basket, a portion of which is defined by the mesh filter element or elements which permit outward flow-through passage of the brewed liquid coffee while substantially preventing outward passage of the coffee grounds.

(Burrows, Col. 2, lines 46-53). It is clear from the description of Burrows that fluid flow is radially outward through the filter 78 and not downwardly as the Office Action alleges.

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Furthermore, due to the positioning of the plenum chamber 70, modification of Burrows would not allow the positioning of a downwardly oriented outlet. Therefore, Burrows does not disclose or suggest a "beverage produced from the water and the quantity of beverage ingredients passes downwardly through the outlet of the insert" as presently claimed.

Cai is relied upon for the purported disclosure of sealing means. In view of the foregoing discussion of Burrows, the proposed modification of Burrows in view of Cai would not result in the claimed insert.

For at least the above discussed reasons, it is asserted that the applied references fail to disclose or suggest claim 1 and thereby Applicants respectfully request reconsideration and allowance of claim 1. Similarly, claims 2-35, dependent from claim 1, are allowable as well for the reasons discussed above.

With regard to the rejection as it applies to claims 4-9, the Office Action has not identified any structure in the applied references that describes or suggests the limitations recited in these claims. Instead, the Office Action states:

However since Burrow teaches a beverage machine with brewing head and brewing basket, thus it would have been obvious to a person of ordinary skill in the art at the time of the invention to insert a rigid or semi-rigid cartridge or any other type of filter (filter bag, flexible filter, filtering membrane, etc) of any of semi-spherical, cylindrical, round or square in shape in the brewing basket to make beverages, since prepacked cartridges can contain a pre-determined dose of coffee and different filter means are suitable for making different kinds of coffee.

(Office Action, page 4). Again, Burrows states that the function of his brew basket is to "stir and agitate the combined body of coffee grounds and water to suspend and swirl the coffee grounds in the form of a water-borne fluidized suspension." (Burrows, Col. 6, lines 18-20). If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP 2143.01. To modify operation of Burrows by using a container with a filter in the brew basket 12 would interrupt the function

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of the brew basket and modify the brew basket 12 unsatisfactory for its intended purpose. As such, placing coffee grounds in a container comprising filtering means and then placing the container into the brew basket 12 would interrupt the function of Burrows' brew basket 12 and modify it unsatisfactory for its intended purpose. Additionally, the brew basket of Burrows functions as both a container and a filter. As such, the Office Action provides no reason for duplicating the containment and filtering functions of the brew basket. Thus, there is no motivation for the proposed modification with respect to claims 4-9.

Claims 26-35 stand rejected under 35 U.S.C. § 103(a) as obvious over Burrows, and in view of Halliday et al. US 2004/0197444 A1 ("Halliday"). In view of the above discussion of Burrows and Cai as applied to claim 1, it is respectfully asserted that claims 26-35, dependent therefrom, are allowable as well.

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CONCLUSION

For the reasons discussed above reconsideration and allowance of claims 1 35, as well as consideration and allowance of claims 52-67, are respectfully requested. The Examiner is invited to contact the undersigned attorney to expedite prosecution.

The Commissioner is hereby authorized to charge any additional fees which may be required with respect to this communication, or credit any overpayment, to Deposit Account No. 06-1135.

Respectfully submitted,
FITCH, EVEN, TABIN & FLANNERY

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